

REMARKS

This is a full and timely response to the outstanding non-final Office Action mailed February 9, 2005. Reconsideration and allowance of the application and presently pending claims 1-19, as amended, are respectfully requested.

1. Present Status of Patent Application

Upon entry of the amendments in this response, claims 1-19 remain pending in the present application. More specifically, claims 1 and 11 are directly amended and claims 12-19 are added. These amendments are specifically described hereinafter. It is believed that the foregoing amendments and additions add no new matter to the present application.

2. New Title

A new title is suggested by the examiner. The current title "Document Transmission Techniques II" is allegedly not descriptive. The Examiner suggests "Authentication Method in a Printing Environment". Applicants have amended the title as suggested by the Examiner.

3. Response to Rejection of Claims 1-10 Under 35 U.S.C. §103

In the Office Action, claims 1-4 and 8-10 stand rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over *Mandelbaum* (EP Patent 0671830A2), in view of *DeBry* (U.S. Patent 6,385,728). Claims 5-7 stand rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over *Mandelbaum* in view of *DeBry* in further view of *Fischer* (EP Patent 0386867B1). It is well-established at law that, for a proper rejection of a claim under 35 U.S.C. §103 as being obvious based upon a combination of references, the cited combination of references must disclose, teach, or suggest, either implicitly or explicitly, all elements/features/steps of the claim at issue. See, e.g., *In Re Dow Chemical*, 5 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1988), and *In re Keller*, 208 U.S.P.Q.2d 871, 881 (C.C.P.A. 1981).

a. Claim 1

Applicants respectfully submit that claim 1, as amended, is allowable for at least the reason that the proposed combination of *Mandelbaum* in view of *DeBry* does not

disclose, teach, or suggest at least the features of “an audit log comprising a list of received document entries, each entry containing a reference to one of the certificates in the store, an encrypted digest corresponding to the received digital document of that entry, and a unique identifier associated with the received digital documents; a decryption algorithm for decrypting the received encrypted digest associated with one of the received digital document selected for verification; and a hash algorithm for creating a digest of the selected digital document such that when the created digest corresponds to the decrypted digest, the digital certificate of the sender is authenticated” as recited in claim 1.

Mandelbaum does not disclose, teach, or suggest using at least the above-recited features of claim 1. *Mandelbaum* is apparently limited to, at most, a system where “all but a header message portion (which identifies an intended recipient) of a received message is restricted, and optionally, encrypted using either a public key, K_{RP} , of an intended recipient or a sender’s private or secret key, K_{SS} .” (Col. 2, Lines 27-32). Thus, *Mandelbaum* fails to disclose, teach or suggest every element of the Applicants’ claimed invention.

DeBry also fails to disclose, teach or suggest at least above-recited features of claim 1. *DeBry* is apparently limited to disclosing “that the user or sender in the system sends a digital certificate to the print server. The print server may authenticate the user online through a certificate authority. The certificate is stored at the print system so that the printer can use the user’s public key to decrypt a random message sent between the user and the printer” as alleged by the Office Action at page 3, lines 22-25. Thus, *DeBry* fails to disclose, teach or suggest every element of the Applicants’ claimed invention.

Accordingly, the proposed combination of *Mandelbaum* in view of *DeBry* does not teach at least the above-recited features of claim 1. Therefore, a *prima facie* case establishing an obviousness rejection by *Mandelbaum* in view of *DeBry* has not been made. Accordingly, claim 1 is not obvious under the proposed combination of *Mandelbaum* in view of *DeBry*, and the rejection should be withdrawn.

b. Claim 2-10

Because independent claim 1 is allowable over the cited art of record, dependent claims 2-10 (which depend from independent claim 1) are allowable as a matter of law for at least the reason that the dependent claims 2-10 contain all features/elements of

independent claim 1. See, e.g., *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988). Accordingly, the rejection to this claim should be withdrawn.

4. Response to Rejection of Claim 11 Under 35 U.S.C. §102(e)

In the Office Action, claim 11 stands rejected under 35 U.S.C. §102(e) as allegedly being unpatentable by *DeBry*. For a proper rejection of a claim under 35 U.S.C. Section 102, the cited reference must disclose all elements/features/steps of the claim. See, e.g., *E.I. du Pont de Nemours & Co. v. Phillips Petroleum Co.*, 849 F.2d 1430, 7 USPQ2d 1129 (Fed. Cir. 1988).

Applicants respectfully submit that independent claim 11, as amended, is allowable for at least the reason that *DeBry* does not disclose, teach, or suggest at least the features of “referencing a digital certificate associated with the selected record, the certificate being one of a store of certificates of received documents and each certificate being associated with a sender of the received digital document; receiving an encrypted digest of the received digital document; decrypting the encrypted digest; computing a value of a second digest from the received digital document; comparing the computed value of the second digest with a value of the decrypted digest; and carrying out an on-line authentication of the certificate when the computed value of the second digest corresponds with the value of the decrypted digest” as recited in claim 11.

Applicants believe that *DeBry* does not disclose, teach, or suggest at least above-recited features of claim 11. *DeBry* is apparently limited to disclosing “that the user or sender in the system sends a digital certificate to the print server. The print server may authenticate the user online through a certificate authority. The certificate is stored at the print system so that the printer can use the user’s public key to decrypt a random message sent between the user and the printer” as alleged by the Office Action at page 3, lines 22-25. However, *DeBry* is completely silent as to the method of authenticating as defined by the features of amended claim 11. Thus, *DeBry* fails to disclose, teach or suggest every element of the Applicants’ claimed invention. Accordingly, *DeBry* does not anticipate claim 11, and the rejection should be withdrawn.

5. Newly Added Claims 12-19

New claims 12-19 are based on subject matter that is explicit and/or inherent within the description of the specification and/or the drawings. The Examiner is respectfully referred to the specification to at least page 22, line 6 through page 26, line 18. Applicants submit that no new matter has been added in the new claims 12-19, and that new claims 12-19 are allowable over the cited prior art. Therefore, Applicants request the Examiner to enter and allow the above new claims.

CONCLUSION

In light of the foregoing amendments and for at least the reasons set forth above, Applicants respectfully submit that all objections and/or rejections have been traversed, rendered moot, and/or accommodated, and that the now pending claims 1-19 are in condition for allowance. Favorable reconsideration and allowance of the present application and all pending claims are hereby courteously requested. If, in the opinion of the Examiner, a telephonic conference would expedite the examination of this matter, the Examiner is invited to call the undersigned agent at (770) 933-9500.

Respectfully submitted,



Raymond W. Armentrout
Reg. No. 45,866